

PATENT

Customer No. 22,852  
Attorney Docket No. 05716.0013-00000

In re Application of:  
Imtiaz RANGWALLA )  
Application No.: 10/823,920 ) Group Art Unit: 1774  
Filed: April 14, 2004 ) Examiner: B. Shewareged  
For: MATERIALS TREATABLE BY ) Confirmation No.: 6117  
PARTICLE BEAM PROCESSING )  
APPARATUS )

**Mail Stop: AF**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

In response to the Final Office Action dated August 25, 2006, the period for response having been extended to January 25, 2006, by a request for an extension of two months and fee payment filed herewith, Applicant respectfully requests reconsideration of this application in view of the following remarks. A Notice of Appeal and appropriate fee are also filed herewith.

Claims 1-13, 15-26 and 38-43 are pending in this application and are subject to examination. Claims 27-37 are withdrawn from consideration. Claim 14 is cancelled. No amendments were made after the Final Office Action.

**I. Summary of the Claimed Invention**

In very general terms, the claimed invention relates to a layered material comprising a substrate, an ink formulation on a portion of the substrate, and a lacquer on at least a part of the ink formulation, where the ink formulation and lacquer are selected to permit at least some bonding to each other. See claims 1, 13, 20 and 38.

**II. Summary of Rejection Under 35 U.S.C. § 103(a)**

The Examiner has rejected claims 1-13, 15-26 and 38-43 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2003/0001108 A1 ("Rangwalla") in view of U.S. Patent No. 5,382,282 ("Pennaz"). Final Office Action, p. 2. The Examiner alleges, *inter alia*, that Rangwalla discloses a packaging material comprising a substrate, a lacquer coating on the substrate and an ink print layer between the lacquer coating and the substrate. *Id.* at 2-3. The Examiner further alleges that Rangwalla discloses that the lacquer and ink are electron beam curable, ***but admits that Rangwalla does not disclose the claimed ink composition.*** *Id.* at 3 (emphasis added). Pennaz is alleged to teach an electron beam curable ink composition for printing. *Id.* The Examiner argues that "it would have been obvious to a person of ordinary skill in the art to combine the ink composition taught by Pennaz with the invention of Rangwalla so as to provide a printed packaging material containing [an] ink composition having enhanced water stability and viscosity." *Id.*

Each independent claim (claims 1, 13, 20 and 38) requires that at least some bonding occur between the ink formulation and the lacquer, or the selection of a portion of each that permits at least some bonding between the two. Regarding these "bonding" claim limitations, the Examiner argues that "because neither Rangwalla nor Pennaz expressly discloses that the ink does not bond with lacquer, and both the ink and the lacquer are cured by the same method of curing, ***the ink inherently bonds with the lacquer.***" *Id.* at 4 (emphasis added). In a subsequent Advisory Action, the Examiner essentially repeats the above arguments, but adds that Applicant must

"provide factual evidence showing that there is no bonding between the ink and the lacquer." December 21, 2006, Advisory Action, p. 2.

### **III. Summary of Argument on Appeal**

Applicant respectfully submits that the Examiner's inherency arguments are improper.

The Examiner bears the initial burden under 35 U.S.C. § 103 of presenting a *prima facie* case of obviousness. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992). "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993), quoting *In re Rinehart*, 189 U.S.P.Q. 143, 147 (C.C.P.A. 1976).

However, when an Examiner is relying on principles of inherency in the prior art in support of a *prima facie* case of obviousness, the initial burden is on the Examiner to produce evidence why the thing absent from the prior art is inherent. *In re Yates*, 211 U.S.P.Q. 1149, 1151 (C.C.P.A. 1981) (finding that when the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, the PTO must produce supporting references). Although inherency may serve as the basis for an obviousness rejection, inherency and obviousness are distinct concepts. *In re Spormann*, 150 U.S.P.Q. 449, 452 (C.C.P.A. 1966) ("That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown.")

In the present case, the Examiner's entire rejection depends upon an alleged inherent property of the combined prior art. Putting aside, for present argument's sake, whether a combination of references may be relied upon to demonstrate an inherent

property of the combined teachings, a reference will contain an inherent characteristic only if that "characteristic is the 'natural result' flowing from the reference's explicitly explicated limitations." *Eli Lilly & Co. v. Barr Labs., Inc.*, 58 U.S.P.Q.2d 1869, 1880 (Fed. Cir. 2001). However, "[o]ccasional results are not inherent." *Mehl/Biophile Int'l Corp. v. Milgram*, 52 U.S.P.Q.2d 1303, 1306 (Fed. Cir. 1999).

While "[t]he express, implicit, and inherent disclosures of a prior art reference may be relied upon in a rejection of claims under 35 U.S.C. § 102 or 103," see M.P.E.P. § 2112, "[t]he mere fact that a certain thing *may* result from a given set of circumstances is not sufficient [to establish inherency]." *In re Oelrich*, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981) (emphasis in original). Only when the Examiner presents evidence or reasoning tending to show inherency does the burden shift to the Applicant to show an unobvious difference. M.P.E.P. § 2112.

[W]hen the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.

*Cont'l Can Co. USA, Inc. v. Monsanto Co.*, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991) (emphasis added), citing *In re Oelrich*, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981).

Applicant respectfully submits that the Examiner has not met the burden of production under 35 U.S.C. § 103(a) and the doctrine of inherency. The Examiner admits on the record that the disclosures in Rangwalla and Pennaz do not teach that the ink and lacquer of those references, if combined, would ever necessarily bond when cured. Notwithstanding his admission, the Examiner goes on to argue that because the

two references do not disclose that the ink and lacquer do not bond, they therefore must inherently bond. See Final Office Action, pp. 3-4.

What is missing from the Examiner's inherency argument, however, is proof!

The Examiner has failed to provide any factual evidence or scientific reasoning that the formulations of the prior art, when combined, would necessarily always (not occasionally) result in bonding. Rather than meeting his initial burden on this point, the Examiner improperly attempts to shift the burden to Applicant by urging the Applicant to "provide factual evidence showing that there is not bonding between the ink and lacquer layer." Advisory Action at p. 2. As noted above, the Examiner has failed to provide any reliable extrinsic evidence to support his position. See *Cont'l Can Co., supra*.

#### IV. Conclusion

For all of the above reasons, the PTO has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103. Accordingly, the rejection should be withdrawn and all non-withdrawn claims deemed allowable. Please charge any fees associated with the filing of this to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

By:

Mike McGurk  
Reg. No. 32,045

Date: January 25, 2007